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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,786	08/15/2001	Ronald E. Sloan	60021-375602	3301

29838 7590 02/15/2008
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EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3692

MAIL DATE	DELIVERY MODE
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02/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/930,786	Applicant(s) SLOAN ET AL.	
	Examiner NGA B. NGUYEN	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/18/02;1/5/04;2/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment filed on November 26, 2007, which paper has been placed of record in the file.
2. Claims 1-42 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-42 have been considered but are not persuasive.

Applicant argued that the *Starr* patent fails to serve as a valid prior art reference under 35 U.S.C. §103(a) because the *Starr* provisional application 60/107,731 fails to provide adequate disclosure to describe and enable the features cited by the Examiner in the later-filed *Starr* patent. Particularly, the provisional application does not disclose "provide the subscriber with a form that allows the subscriber to enter a customer identifier and password, the server processes the data to determine whether the subscriber is an authorized user the level of access to be granted to the subscriber."

The provisional application contains only a brief description of providing "access control", and does not provide an enabling disclosure of how such control could be implemented in a financial system or financial system. The brief mention of "access control" in the *Starr* provisional application does not teach or suggest the service level agreement features as claimed in the present invention. **Examiner disagrees.**

Examiner submits that *Starr* disclose in the provisional application 60/107,731 page 2, first paragraph that "the server can provide to the payroll service provider information

that is representative of a user ID number, a PIN number, and access control number, or any other type of information that is required by the payroll service provider to perform the financial transaction requested by the systems subscriber." Moreover, Starr discloses in page 4, last paragraph through page 5, first paragraph that "the access control is part of the application server's ability to provide multiple access to a small business owner's accounts by allowing multiple users to share the account", "the application server can allow a proprietary user, such as the root user, to set up a plurality of accounts, such as account for their accountants or secretary. The small business owner can provide controls that set the access the other user is given. For example, the accountant can be given the control necessary to prepare bills for being paid electrically, however, can lack the necessary level of access to be able to actually kick off electronic payment", "other access controls can be set up to provided some users with view only control of monies in certain accounts. Other levels of access and control can be provided. Similarly, a new employee in a company being entered initially into a database by a user with ADMINISTRATOR PRIV. level which enrolls the employee in LTD, STD, health care, payroll deductions, etc. with entry of information. Another level of access is provided to this information by a user with REPORTING LEVEL access which allows READ ONLY access to the information and does not permit changing any information in the system/querying only access." Thus, the Starr provisional application clearly discloses the details of access control and the level of access. Therefore, the Starr patent is a valid prior art reference under 35 U.S.C. §103(a) because the Starr provisional application 60/107,731 does provide adequate

disclosure to describe and enable the features cited by the Examiner in the later-filed Starr patent. Particularly, the provisional application does disclose "provide the subscriber with a form that allows the subscriber to enter a customer identifier and password, the server processes the data to determine whether the subscriber is an authorized user the level of access to be granted to the subscriber

Moreover, in response to the applicant's arguments that the Starr provisional application fails to teach or suggest any correlation between providing various service levels and portfolio modeling and coaching. The provisional application also fails to teach or suggest the feature of identifying a financial model selected from a set of financial models based on the selected service agreement. The provisional application, in fact, fails to make any mention of financial modeling, coaching, portfolio services, or any related concepts, examiner submits that the Supreme Court in KSR described the rationales to support rejections under 35 U.S.C. 103: Combining prior art elements according to known methods to yield predictable results; Simple substitution of one known element for another to obtain predictable results; Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. In this case, the primary reference Wallman discloses identifying a financial model selected from a set of financial models and financial modeling, coaching, portfolio services. The secondary reference Starr discloses access control and levels of access, providing account data in accordance with access levels. Therefore, it would be obvious to combine features of access control and levels of access, providing account data in

accordance with access levels because there would be predictable results. For example, it would be predictable that the user is provided access to the financial information in the user's financial portfolio based on the user access level, would result in restricting the user access to a specific financial information based on the level of access in order to enhance security in accessing and processing financial information.

For the reason set forth above, examiner decides to maintain the previous rejections (also see details below) and make this Office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-15, 30, 31, and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Starr, U.S. Patent No. 6,606,606.

Regarding to claim 1, Wallman discloses a method for developing a web-based financial portfolio remotely over the Internet comprising:

identifying a current financial portfolio of a user (column 23, line 62-column 24, line 25; the investor selects his desired portfolio based on his various preferences);

identifying a financial model including a user profile based on personal financial parameters of the user including at least a risk tolerance level (column 23, lines 20-40; column 29, lines 10-20 and figure 2; the investor creates new account with the system, the system creates the investor's profile including name, address, payment information, the investor's risk tolerance, financial goals, objectives, the investor's current assets and liabilities, current and expected income, etc.); and

providing to the user over an Internet customized financial coaching tailored to life intentions of the users, wherein the customized financial coaching includes suggestions for changes to the current financial portfolio reflecting the user profile (column 28, lines 10-27, the investor access the system over the Internet; column 24, lines 1-25; column 26, lines 28-35; column 31, lines 30-50; the system suggest for changes to the current financial portfolio to satisfy the investor's preferences), wherein

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the suggestions are presented in a natural language format (column 38, line 55-column 39, line 35; column 32, lines 40-60) and wherein the suggestions include financial products and recommended securities for user to purchase (column 14, lines 45-57; column 25, lines 23-65; column 26, lines 10-65; column 30, line 32-column 31, line 15; the system recommends the portfolios including a lists of securities for the investor to purchase).

Wallman does not discloses identifying a current financial portfolio of a user in response to a selected service agreement, wherein the selected service agreement is chosen from a plurality of different service agreements providing various service levels related to portfolio modeling and coaching, and identifying a financial model selected from a set of financial model based on the selected service agreement. However, Starr discloses identifying a current financial information of a user in response to a selected service agreement, wherein the selected service agreement is chosen from a plurality of different service agreements providing various service levels related to financial information, and identifying a financial information selected from a set of financial information based on the selected service agreement (column 7, line 5-65; column 8, lines 45-65; an access control process determines, in response to information provided by the subscriber, **an access level** to grant to the subscriber, e.g. the payroll person is allowed to employ the payroll service but is prevented from accessing the CMA account for general check writing privileges; the user interface can provide the subscriber with a form that allows the subscriber to enter a customer identifier and a password, the server processes the data to determine whether the subscriber is an authorized user an the

level of access to be granted to the subscriber). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to adopt the teaching of Starr above, for the purpose of restricting the user access to a specific financial information based on the level of access in order to enhance security in accessing and processing financial information.

Regarding to claim 2, Wallman discloses wherein the personal financial parameters further include: a user investment style; and a user bull/bear market attitude (column 23, lines 35; column 26, lines 10-15; column 29, line 58-column 30, line 25; the investor's preference).

Regarding to claims 4-5, Wallman does not disclose wherein said user investment style is determined by: displaying to the user a series of test scenarios; and generating said user investment style based on the user responses to these test scenarios and wherein said user bull/bear attitude is determined by: displaying a series of user selected expert opinions; analyzing the user's response to the opinions; and generating said user bull/bear attitude based on the user responses. However, it is well known in the art to determine investment style and bull/bear attitude based on the user responses the series of questions. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to include the feature above for the purpose of providing more efficiency in determining the investor's investment style and bull/bear attitude in order to suggesting and recommending securities for the investor to purchase.

Regarding to claim 6, Wallman discloses filtering a list of securities based on the user profile, wherein filtering the list of securities yields the recommended securities; and presenting the recommended securities to the user for possible security swaps, wherein securities can be added to or removed from the portfolio (column 26, lines 28-35).

Regarding to claim 7, Wallman discloses wherein filtering the list of securities comprises:

obtaining a Value At Risk (VAR) value and a Beta value for each security in the list of securities (figures 5, 13 and column 37, lines 58-66; Differential return relative to S&P 500 56b-56h is VAR, risk relative to S&P 500 55b-55h is beta value);

rejecting securities in the list of securities not complying with the user profile based on the VAR values and the Beta values (column 26, lines 5-10).

Regarding to claim 8, Wallman discloses wherein a risk management model is used to calculate a user VAR value and a user Beta value for the portfolio (column 14, lines 10-18; the risk an differential return calculation process calculates risk and a differential return of the entire investor portfolio relative to standard industry measurements or absolute values).

Regarding to claim 9, Wallman discloses comparing the user VAR value and the user Beta value to a VAR value and a Beta value of various user selected market indices; and displaying the result to the user in a graph (column 26, lines 37-45 and column 32, lines 29-67).

Regarding to claims 10-11, Wallman discloses wherein a compound growth factor is calculated by: using linear regression and natural logarithm and wherein a future performance of the portfolio is projected using the compound growth factor (figure 13, the expected differential in portfolio return is calculated relative to S&P 500).

Regarding to claim 12, Wallman discloses comprising: allowing the user to select at least one security from the filtered list of securities; swapping the selected securities with securities in the portfolio; and analyzing and displaying the effect of said swapping on the portfolio (column 26, lines 28-45).

Regarding to claims 13, Wallman does not disclose wherein the filtered list of securities is displayed in a first column and a second column, wherein securities with positive Beta values are displayed in the first column and securities with negative Beta values are displayed in the second column. However, Wallman does disclose filtered list of securities is displayed in a first column and Beta values are displayed in a second column (see figures 5 and 13). Moreover, it is well known in the art to display the securities with positive Beta values in the first column and the securities with negative Beta values in the second column. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to include the feature above for the purpose of helping the investor more easily in selecting securities to purchase.

Regarding to claim 14, Wallman discloses wherein a financial model developer creates an ideal portfolio based on the user profile (column 25, lines 23-30; column 30, line 32-column 31, line 15).

Regarding to claim 15, Wallman discloses wherein the user has access to automated computer coaching and live coaching based on a service level agreement (column 29, lines 37-50; the system determines whether the investor is an accredited investor or a qualified investor; column 35, lines 3-15; the accredited investor can engage in chat room activities).

Claims 30, 31, 33-42 are written in computer software that parallel the limitations found in claims 1, 2, 4-15 above, therefore, are rejected by the same rationale.

7. Claims 3 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Starr, U.S. Patent No. 6,606,606, and further in view of Rebane, U.S. Patent No. 6,078,904.

Regarding to claims 3 and 32, Wallman does not disclose wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses. However, Rebane discloses wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses (column 17, line 48-column 22, line 45). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to adopt the teaching of Rebane for the purpose of providing more efficiency in determining the investor's risk tolerance level in order to suggesting and recommending securities for the investor to purchase.

8. Claims 16, 17, and 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Starr, U.S. Patent No. 6,606,606, and further in view of Deep, U.S. Patent No. 6,393,412.

Regarding to claim 16, Wallman discloses a system for developing a web-based financial portfolio remotely over the Internet comprising:

a portfolio generator used to model a current financial portfolio for a user (figure 1; column 23, lines 10-20; column 25, line 65-column 26, line 10; the portfolio selection editor 2);

a user profile generator for generating a user profile based on personal financial parameters of the user, wherein the user profile includes at least a risk tolerance level (figure 1 and column 23, line 10-47; the asset allocation model 1);

a computer coaching server coupled to the Internet (figure 1; column 23, lines 20-20, the web server 3 or figure 6; column 28, lines 10-37, the web server 14), wherein the computer coaching server provides automated financial coaching presented in a natural language format (column 38, line 55-collumn 39, line 35; column 32, lines 40-60); wherein said computer coaching server recommends changes to the financial portfolio based on the user profile, including providing customized financial coaching tailored to the life intentions of the user and providing suggestions of financial products and recommended securities for the user to purchase (column 25, lines 23-65; column 26, lines 10-65; column 30, line 32-column 31, line 15; the system recommends the portfolios including a lists of securities for the investor to purchase).

Wallman does not disclose identifying a current financial portfolio of a user in response to a selected service agreement, wherein the selected service agreement is chosen from a plurality of different service agreements providing various service levels related to portfolio modeling and coaching, and identifying a financial model selected from a set of financial model based on the selected service agreement. However, Starr discloses identifying a current financial information of a user in response to a selected service agreement, wherein the selected service agreement is chosen from a plurality of different service agreements providing various service levels related to financial information, and identifying a financial information selected from a set of financial information based on the selected service agreement (column 7, line 5-65; column 8, lines 45-65; an access control process determines, in response to information provided by the subscriber, ***an access level*** to grant to the subscriber, e.g. the payroll person is allowed to employ the payroll service but is prevented from accessing the CMA account for general check writing privileges; the user interface can provide the subscriber with a form that allows the subscriber to enter a customer identifier and a password, the server processes the data to determine whether the subscriber is an authorized user and the level of access to be granted to the subscriber). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to adopt the teaching of Starr above, for the purpose of restricting the user access to a specific financial information based on the level of access in order to enhance security in accessing and processing financial information.

Moreover, Wallman does not disclose a live financial advisor server coupled to the Internet recommends changes to the financial portfolio based on the user profile, including providing customized financial coaching tailored to the life intentions of the user and providing suggestions of financial products and recommended securities for the user to purchase. However, Deep discloses a live financial advisor server coupled to the Internet recommends changes to the financial portfolio based on the user profile, including providing customized financial coaching tailored to the life intentions of the user and providing suggestions of financial products and recommended securities for the user to purchase (column 3, lines 17-30 and column 5, line 28-column 6, line 5; the user and the financial advisor can communicate via a chat room over the Internet, the advisor recommends changes to the financial portfolio based on the user profile, recommends the securities to sell or purchase). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to adopt the teaching of Deep for the purpose of allowing the investor to communicate directly with a live financial advisor, thus the investor can get the recommended securities to purchase directly from a live financial advisor.

Claims 17, 19-29 contain similar limitations found in claims 2, 4-15 above, therefore are rejected by the same rationale.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044, in view of Starr, U.S. Patent No. 6,606,606, in view of Deep, U.S. Patent No. 6,393,412, further in view of Rebane, U.S. Patent No. 6,078,904.

Regarding to claim 18, Wallman, Starr and Deep do not disclose wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses. However, Rebane discloses wherein said user risk tolerance level is determined by: displaying to the user a series of progressively more negative financial scenarios; analyzing a response to each negative scenario received the user; and generating the risk tolerance level based on the user's responses (column 17, line 48-column 22, line 45). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's modified by Deep above to adopt the teaching of Rebane for the purpose of providing more efficiency in determining the investor's risk tolerance level in order to suggesting and recommending securities for the investor to purchase.

Conclusion

10. Claims **1-42** are rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

February 5, 2008